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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,602	06/23/2003	Tetsuro Tayu	50195-366	9582

7590 11/21/2005  
McDERMOTT, WILL & EMERY  
600 13th Street, N.W.  
Washington, DC 20005-3096

EXAMINER
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SHEEHAN, JOHN P

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 11/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/600,602	<b>Applicant(s)</b> TAYU ET AL.	
	<b>Examiner</b> John P. Sheehan	<b>Art Unit</b> 1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-12 and 14-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-7, 12, 15, 21-23, 25, 26, 28-30, 32 and 33 is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 8-11, 14, 16-20, 24, 27, 31 and 34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 17, 2005 has been entered.

### ***Specification***

1. Regarding the incorporation by reference, the applicants have requested that the Examiner identify the essential material that needs to be included in the specification so that applicants can prepare and submit an amendment to the specification if necessary. At this time, the Examiner is not aware of any essential subject matter that has been incorporated by reference that needs to be included in the specification by amendment.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 1742

3. Claims 1, 3, 4, 8 to 11, 14 and 16 to 20, 24, 27, 31 and 34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

I. In claims 1, 3, 4, 8 to 11, 16 to 20, 27 and 34, the new limitation, “an electric resistivity of...26  $\mu\Omega\text{m}$  or more” (see independent claims 1 and 8 and dependent claims 27 and 34) encompasses resistivity values of 50, 100, 150, 300, 500, 1000  $\mu\Omega\text{m}$ , etc. However such values of resistance do not find support in the application as filed, therefore the limitation, “an electric resistivity of...26  $\mu\Omega\text{m}$  or more” is considered drawn to new matter, MPEP 2163.05 III.

II. In claims 9, 14, 16, 24 and 31, the new lower limit of 10  $\mu\text{m}$  recited “in a range from 10 to 500  $\mu\text{m}$ ” does not find support in the application as filed, therefore the limitation, “in a range from 10 to 500  $\mu\text{m}$ ” is considered drawn to new matter, MPEP 2163.05 III.

***Allowable Subject Matter***

1. Claims 5 to 7, 12, 15, 21 to 23, 25, 26, 28 to 30, 32 and 33 are allowed.
2. The following is a statement of reasons for the indication of allowance:

Art Unit: 1742

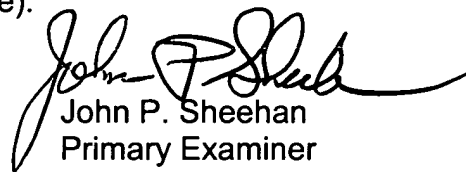
3. Regarding claims 5 to 7, 12 and 15, the primary reason for allowance is that none of the references alone or in combination teach or suggest the method recited in claim 5 where the molding step is performed at 600<sup>0</sup>C to 850<sup>0</sup>C.
4. Regarding claims 21 to 23, 25, 26, 28 to 30, 32 and 33, the primary reason for allowance is that one of the references alone or in combination teach or suggest the magnet and the motor made from the claimed magnet wherein the "rare earth oxide being present only between the rare earth magnet particles" (emphasis added by the Examiner).
5. The rejections of claims 1, 3, 4, 8 to 11, 16 to 20 based on Japan '610 have been overcome in view of the new claim limitation "an electric resistivity of...26  $\mu\Omega\text{m}$  or more" added to the claims and applicants' arguments set forth in their response on page 11, lines 1 to 5. It is noted that, as set forth above, these claims and additionally claims 27 and 34 have been rejected as drawn to new matter in view of the new claim limitation, "an electric resistivity of...26  $\mu\Omega\text{m}$  or more".

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (571) 272-1249. The examiner can normally be reached on T-F (6:45-4:30) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
John P. Sheehan  
Primary Examiner  
Art Unit 1742

jps